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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,966	02/04/2004	Michael A. Carmody	D5407-197	3855
25397	7590	03/07/2006	EXAMINER	
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027			SMITH, MATTHEW J	
			ART UNIT	PAPER NUMBER
			3672	
DATE MAILED: 03/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/771,966	CARMODY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Matthew J. Smith	3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 10 and 20 is/are allowed.
- 6) Claim(s) 1-9 and 11-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 11, 13-16, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

For claims 1-5, 7, 11, and 13, the recitation of the cover flexing is not supported by the written description. In paragraph [0026], "The purpose of the material 30 is to allow flexing in response to increasing hydrostatic pressure ...", does not imply the cover flexes. The description continues, stating "Sleeve 20 is preferably fiberglass ..." which is not inherently flexible. Further stating non-metallic or plastic also does not imply a sleeve material is flexible.

For claims 13 and 14, the steps appear out of order. The step of "removing the sleeve" can not be followed by the step of "creating a sealed annular space". This "creating a sealed annular space" step would appear to be best inserted after the providing step.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-9, 11-13, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Mackay (6655459).

Mackay discloses a casing shoe 100 comprising: a body 110 having an internal recess 132 and a passage 123; a cover 131 mounted over the recess to protect the recess from debris accumulation resulting from cementing the body downhole; the cover removable (col. 5, line 40) subsequent to cementing of the body to expose the recess; the cover sealed to the body to define an enclosed annular space 132 adjacent the recess; the annular space contains a loosely packed incompressible material 122 that inherently flexes (note, col. 5 line 19); a tubular 210 inserted through the shoe after removal of the cover for attachment to the recess; the tubular attached to the recess by expansion (figure 4); and the body having a drift diameter outside of the recess and the tubular, after expansion into the recess, at least as large as the drift diameter in the shoe outside of the recess (figure 8).

This reference also discloses a well completion method comprising: running in a tubular 101 having a shoe 120 at its lower end; providing a sleeve 131 to cover a recess in the shoe; cementing the tubular downhole; removing the sleeve after the cementing to expose the recess (col. 5, line 40); creating a sealed annular space 132 around the recess with the sleeve; inserting a tubular string 210 after removal of the sleeve; expanding the tubular string into the recess for support (figure 4); and providing a drift diameter for the tubular string, after the expansion, at least as large as the drift diameter of the shoe outside of the recess (figure 8).

***Allowable Subject Matter***

Claim 10 and 20 are allowed.

Claim 14-16 and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 23 January 2006 have been fully considered but they are not persuasive. Upon further review, the examiner contends it is the sand that is compliant and the written description does not clearly convey applicant's sleeve 20 can bend repeatedly. Since sand is disclosed by MacKay, stated or not, it is the property of the sand responsible for flexing and thus anticipated. The examiner apologizes for not addressing this issue in the first Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

MJS *MJS*  
2 March 2006



Jennifer H. *Gay*  
Primary Examiner